

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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JULES D. GRATIOT and AIR-MAZE CORPORATION,  
*Appellants,*

*vs.*

FARR COMPANY, a corporation,  
*Appellee.*

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## SUPPLEMENTAL BRIEF OF APPELLANTS.

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HYDE, MEYER, BALDWIN & DORAN,  
GEORGE S. BALDWIN,  
1430 Keith Building,  
Cleveland 15, Ohio,

HARRIS, KIECH, FOSTER & HARRIS,  
FORD HARRIS, JR.,  
DONALD C. RUSSELL,  
417 South Hill Street,  
Los Angeles 13, California,  
*Attorneys for Appellants.*

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**PAUL P. O'BRIEN, CLERK**



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### I.

#### Supplementary Statement of the Case.

##### 1. Introduction.

By an order dated May 27, 1953 [R. 1186], this Court remanded this case to the District Court for the taking of further evidence with regard to an air filter known as the "Kleenaire" filter, which, it is asserted by the defendants, was in public use and on sale long prior to the invention of the Farr patent (No. 2,286,479) in suit and anticipates and invalidates the patent in suit. Such evidence was heard by the District Court and on November 19, 1954, the District Court entered its judgment [R. 1182] that the new evidence required no modification of its earlier judgment [R. 67], holding the patent in suit

valid and infringed by appellants. By its second notice of appeal [R. 1183] appellants appealed from this second judgment of the District Court sustaining the patent in suit. The District Court confined the rehearing to evidence with respect to the "Kleenaire" filter [R. 1187].

This brief is supplemental to the briefs already on file herein and does not repeat the arguments set forth therein. There are two forms of "Kleenaire" filters presented by the new evidence in this case: (a) one form in which the crimps or corrugations of the wire screen were at an angle of about  $9^\circ$  to the face of the filter; and (b) another form in which the crimps were at an angle of about  $45^\circ$  to the face of the filter.

## 2. The " $9^\circ$ Kleenaire" Filter.

The District Court found that prior to the date of invention of the Farr patent (No. 2,286,479) in suit, "Kleenaire" filters as disclosed in the bulletin, Defendants' Exhibit HHH, were made and sold, and that the sample filters, Defendants' Exhibits SSS and TTT, are specimens thereof [Finding 24, R. 1178]. Plaintiff, in addition, expressly admitted that copies of such bulletin, Exhibit HHH, were printed and distributed to the public in 1931 and/or 1932, and that such "Kleenaire" filters were in public use in the United States prior to July 1, 1937 [plaintiff's answers 1-4 to Request for Admissions, R. 1171-1172]. Such filters are hereinafter referred to as the " $9^\circ$  Kleenaire."

Consequently, there is no issue on this appeal as to the fact of the public use and sale of such " $9^\circ$  Kleenaire" filters long prior to the alleged invention of the patent in suit or as to their construction. The primary question

with regard thereto is: Did the prior use and sale of the "9° Kleenaire" filter invalidate the Farr '479 patent in suit? There are the subsidiary questions, of course, as to whether the "9° Kleenaire" filter had substantially the same construction and operated in substantially the manner to produce results comparable to the results of the alleged invention claimed in Farr '479 patent in suit.

The "9° Kleenaire" was made and sold in substantially the same sizes as certain of the Farr filters made and sold by plaintiff under the '479 patent in suit. The "9° Kleenaire" was made in Types "A" and "B," Type "A" being 20" x 20" x 4" and Type "B" being 20" x 20" x 2½" [R. 1222-1226, 1232, 1236]. The plaintiff's Farr filter is likewise made in about the same sizes [Ex. 7].

The "9° Kleenaire" filter was formed of a plurality of rectangular strips or sheets of metal fly screen of 14 or 16 mesh [R. 1340, 1379-1382]. The plaintiff's Farr filter is likewise made of 14 mesh screen [R. 173, 1340].

In the "9° Kleenaire" filter the strips of fly screen were crimped to form corrugations extending at an angle of about 9° with respect to the long edges of the strips [R. 1346]. The strips were packed together, one on top of the other, in a metal frame, with alternative strips placed so that the angles of the corrugations were reversed in direction [R. 1341]. Thus, adjacent strips were in contact only where the corrugations crossed [R. 1341]. In the defendants' accused P-5 filter, its corrugated strips of fly screen are likewise packed together in a frame with alternate strips having the corrugations reversed in direction, so that adjacent strips are in contact only where the corrugations cross [R. 1342]. Such reversal of direction of the corrugations of adjacent strips in the "9° Kleen-

aire" prevents the strips from nesting together [R. 1341]. The reversal of direction of the corrugations of the defendants' accused P-5 filter likewise prevents the strips from nesting together.

In the "9° Kleenaire" the corrugated screen strips, touching only where the oppositely directed corrugations cross each other, provide open zig-zag passages or channels through the filter which go over and under the points of contact of the corrugations [R. 1405-1406]. Such zig-zag passages are clearly shown in Exhibit HHH [R. 1462] by the zig-zag line labeled "air flow" in the right-hand illustration [R. 1348], and are fully described in the exhibit [R. 1461]. The existence of such open zig-zag passages in the "9° Kleenaire" was also clearly admitted by plaintiff's expert Duncan [R. 1405] and described by defendants' expert Russell [R. 1342-1344].

The purpose of the open zig-zag air passages or channels in the "9° Kleenaire" was to provide open paths for the free passage of air through the filter even when loaded with dust, to prevent an undue increase of resistance to air flow as the filter becomes loaded with dust. This is described in Exhibit HHH [R. 1461] as follows:

" . . . Due to the free passage of air allowed by the channels, a heavy dust load causes only a negligible increase in resistance. This is due to the fact that the dust load is carried on the walls of the air passages, instead of matting over the face of the filter . . .

"It will be noted from the resistance pressure curves of the graph that KLEENAIRE FILTERS have a very low resistance to the air stream. This is due to the special channels in the filter medium."



The Farr '479 patent in suit likewise teaches the desirability of providing open air passages through its filter to maintain a relatively low increase in pressure drop with an increase in the dust load in the filter [R. 840, col. 1, lines 32 to 53].

### 3. The "45° Kleenaire" Filter.

Another form of "Kleenaire" filter is shown in the publication, Defendants' Exhibit CCC [R. 1458, 1459], which publication plaintiff has admitted was published in the United States in the year 1931 (by plaintiff's failure to respond to defendants' Request for Admission [R. 1163]). This filter was similar to the "9° Kleenaire" except that the corrugations of the wire screen strips were at an angle of about 45° to the long edges of the strips. This filter is referred to hereinafter as the "45° Kleenaire" to distinguish it from the "9° Kleenaire."

Although there was evidence to the effect that the "45° Kleenaire" was actually made and sold in the same sizes as the "9° Kleenaire" prior to the latter [R. 1206, 1209-1210, 1230, 1233, 1249-1250], the District Court found [Finding 33, R. 1180] that the evidence was insufficient to establish that any such "45° Kleenaire" filters were ever actually made and sold. It is, therefore, an issue here as to whether such "45° Kleenaire" filters were actually made and sold prior to the invention of the Farr '479 patent in suit so as to invalidate the patent in suit. There is no question, however, that such "45° Kleenaire" was shown and offered for sale in the publication published in 1931, long prior to the invention of the patent in suit.

## II.

**Specification of Errors in New Findings of Fact of the District Court**

1. Finding 26 [R. 1178] is erroneous in finding that the Kleenaire filters had no utility, because many of such filters were made, sold, and satisfactorily used commercially and the Court erred in failing to so find.

2. Finding 27 [R. 1178] is erroneous in finding that the terms "passages," "passages changing direction," "passages being disposed angularly," and "passages changing abruptly in direction" employed in claim 4, 5, 7, and 8 of the Farr patent in suit have only the limited meanings set forth in said Finding, because such terms are broad enough to embrace the zig-zag air passages of the Kleenaire filters and the Court erred in failing to so find.

3. Finding 28 [R. 1179] is erroneous in finding that the Kleenaire filters do not have the air passages called for by claims 4, 5, 7 and 8 of the Farr patent in suit, because such Kleenaire filters have open zig-zag air passages substantially the same as the passages of such claims and the Court erred in failing to so find.

4. Finding 29 [R. 1179] is erroneous in finding that the Kleenaire filters do not disclose the combination of elements of claims 4, 5, 7 and 8 of the Farr patent in suit referred to in Finding 9 or otherwise, because such Kleenaire filters in fact embodied the exact combinations of said claims.

5. Finding 29 [R. 1179] is erroneous in finding that if the Kleenaire filter had been subsequent to the Farr patent in suit it would not infringe the patent in suit, because unsupported by and contrary to the evidence.

6. Finding 29 [R. 1179] is erroneous in finding (if it does so find) that the claims of the Farr patent in suit set forth any new combination of elements, because all of the elements of such claims were embodied in such Kleenaire filters.

7. Finding 30 [R. 1179] is erroneous in finding that the Kleenaire filters do not have the mode of operation referred to in Finding 4, because unsupported by and contrary to the evidence.

8. Finding 30 [R. 1179] is erroneous in finding (if it does so find) that Finding 4 sets forth any new mode of operation, because contrary to the evidence.

9. Finding 30 [R. 1179] is erroneous in finding that the dust load accumulates on the face of the Kleenaire filter, because unsupported by and contrary to the evidence.

10. Finding 31 [R. 1180] is erroneous in finding that the Kleenaire filters did not achieve the results described in Finding 6, because contrary to the evidence.

11. Finding 31 [R. 1180] is erroneous in finding (if it does so find) that the results described in Finding 6 were either new or surprising, because unsupported by and contrary to the evidence.

12. Finding 32 [R. 1180] is erroneous in finding that the evidence as to the Kleenaire filter was only cumulative, because no prior art filter of the Kleenaire type was previously in evidence herein.

13. Finding 32 [R. 1180] is erroneous in finding (if it does so find) that the Kleenaire filters did not contain either the elements, the mode of operation, or the results of the filter of the Farr patent in suit, because contrary to the evidence.

14. Finding 32 [R. 1180] is erroneous in finding (if it does so find) that the results of such Farr filter were either new or surprising, because the same were old in the art.

15. Finding 32 [R. 1180] is erroneous in finding that the filter of the Farr patent in suit was not obvious to one skilled in the art either from such Kleenaire filters alone or in connection with the other prior art of record such as the Detroit paper filters, because unsupported by and contrary to the evidence.

16. Finding 33 [R. 1180] is erroneous in finding that there is no preponderance of evidence, or that the evidence was insufficient to support a finding that any Kleenaire filters were ever made and sold which differed from those described in the bulletin, Defendants' Exhibit HHH, or the specimens, Defendants' Exhibits SSS and TTT, or which had filter media with corrugations at a 45° angle or any other angle such that the corrugations did not terminate at one end or other in the filter frame, because the evidence was insufficient to support such a finding and there was no contrary evidence, and the Court erred in failing to find that Kleenaire filters having such corrugations at approximately a 45° angle were in public use and on sale in the United States long prior to the invention of the Farr patent in suit.

17. Finding 34 [R. 1181] is erroneous in finding that the evidence presented with respect to the Kleenaire filter in no way "effects" (*sic*) or requires any modification of previous Findings 8 and 15.

### III.

#### The Argument.

#### 1. The Kleenaire Filters Embodied All of the Alleged Essential Elements of the Farr '479 Patent in Suit.

In the Court below plaintiff's counsel enumerated the alleged *essential* elements of the Farr '479 patent in suit as follows:

“Mr. Leonard S. Lyon: May the Court please, at the outset of this case I stated that the filter of the panel of the patent in suit had a novel construction and that the essential elements of that construction consisted, first, of a plurality of sheets of crimped wire screen arranged parallel to the direction of air-flow and forming passages through the filter.

Second, that the sheets divided the panel in two dimensions into a plurality of subdivisions.

Also, third, that a portion of each of the passages was disposed angularly so as to provide a change of direction of the flow of the air through the passages.

I stated that those were the essential characteristics of this patented filter. Mr. Duncan's testimony was to the same effect. \* \* \*” [R. 813].

The Brief for Appellee (p. 13) likewise admits that the foregoing three elements are the essential elements of the patent in suit.

Each of said three so-called essential elements of the Farr patent in suit are plainly embodied in the Kleenaire filters, as shown by the testimony of Mr. Duncan, plaintiff's expert witness, and confirmed by Mr. Russell, defendants' expert.

The Kleenaire filters each included “a plurality of sheets of crimped wire screen arranged parallel to the direction

of air flow," such screens forming "passages through the filter," the screen sheets subdividing the panel in two dimensions into a plurality of subdivisions [R. 1339, 1342-1346, 1427], and the passages changing "direction" [R. 1349, 1428]. As pointed out by Mr. Duncan [R. 1428], the changes in direction of the zig-zag passages of the Kleenaire filter are illustrated by the colored strings in physical Exhibit VVV.

Thus, the Kleenaire filters embodied all of the elements that plaintiff has identified as being *essential* in the filter of the Farr '479 patent in suit.

## 2. The Kleenaire Filters Embodied All of the Elements of the Claims of the Farr '479 Patent in Suit.

In a patent case we are primarily concerned with the claims of the patent in suit, because the claims define the alleged invention. See: *Milcor Steel Co. v. George A. Fuller Co.*, 316 U. S. 143, 145, 86 L. Ed. 1332, 1334, 62 S. Ct. 969 (1942); *Gasair Corporation v. Ransome Co.*, 140 F. 2d 818, 819 (C. C. A. 9th, 1944).

We submit that every element of claims 4, 5, 7 and 8 of the Farr '479 patent in suit was embodied in both of the Kleenaire filters and particularly in the "9° Kleenaire." Illustrative of this, claim 5 of the patent in suit, as shown by the undisputed evidence, may readily be applied to the "9° Kleenaire" filter as follows:

Claim 5 covers "a filter panel operating on the principle of impingement of particles on collecting surfaces." Plaintiff's expert Duncan admitted that the "9° Kleenaire" was such a filter [R. 1427], which was confirmed by defendants' expert Russell [R. 1338].

Claim 5 includes "a plurality of sheets of crimped mesh screening members positioned with the sheets extending in the general direction of the intended flow through the panel of the medium to be filtered." Mr. Duncan admitted that the "9° Kleenaire" has such members [R. 1427], and this was confirmed by Mr. Russell [R. 1339].

Claim 5 specifies: "the crimp of said sheets being constructed and arranged to effect a multiple subdivision of the panel in both dimensions perpendicular to the general direction of flow of the medium to be filtered." Mr. Duncan admitted that the "9° Kleenaire" has such a construction [R. 1427].

Claim 5 requires that the screen members be constructed and arranged so as to form "passages the walls of which are composed of such mesh members, which passages extend through said panel." Mr. Duncan admitted that by reason of the arrangement of the corrugated screen members of the "9° Kleenaire" open zig-zag air paths, channels, or passages are formed through it [R. 1405-1406], which was confirmed by Mr. Russell [R. 1342-1344].

Mr. Duncan admitted that in the Kleenaire the walls of such passages "are composed of such mesh members" [R. 1427-1428], and confirmed by Mr. Russell [R. 1348-1349].

Claim 5 further provides for a portion of each of "said passages being disposed angularly with respect to a remaining portion of the passages." Mr. Duncan admitted that the open zig-zag passages of the "9° Kleenaire" change direction [R. 1428], which was confirmed by Mr. Russell [R. 1349].

It is plain that every element of the structure set forth in claim 5 of the Farr '479 patent in suit was present in the same alleged combination in the "9° Kleenaire" filter. The same is similarly true of claims 4, 7 and 8 in suit. There was no contrary evidence. This clearly demonstrates the error in Finding 29 [R. 1179] here in issue, and in original Finding 8 [R. 61].

The District Court to avoid a holding of invalidity of the Farr '479 patent in suit interpreted the term "passages" extremely narrowly, limiting such term by construction to mean the screen corrugations themselves [Finding 27, R. 1178], and thereby distinguishing from the "9° Kleenaire" filter in which the corrugations do not extend entirely through the filter [Finding 28, R. 1179]. In doing so, the District Court merely referred to the Farr '479 patent itself [R. 1441-1445], without recourse to any other evidence.

This Court, of course, can read the Farr '479 patent in suit as readily as the District Court, and, we suggest, there is absolutely nothing in the specification or the patent in suit to justify any reading of such limitations into the claims in issue which do not contain any such limitations. It is true that the drawing of the Farr patent in suit shows triangular passages 5 formed by the corrugations in the crimped screens 4 together with the flat intermediate screens 9. Likewise, the Farr specification plainly teaches that its air passages are formed by the crimped or corrugated screens "in cooperation with adjacent screen members" [R. 840, Col. 2, lines 19-24], and the only "adjacent" screen members disclosed in the Farr patent are the flat screens 9. If the claims in suit are to be limited by interpretation to such passages shown



and described in the patent they should be further limited to the inclusion of such flat screens, in which case the defendants' accused P-5 filter, which does not include any such flat screens, does not infringe the patent in suit. The claims in issue, we suggest, should not be interpreted narrowly to avoid invalidity and then broadly to find infringement. This demonstrates the clear error in Findings 27 and 28 [R. 1178-1179].

**3. The Kleenaire Filters Operated in Substantially the Same Way as the Farr '479 Filter.**

Plaintiff's expert Duncan made and fully tested a replica of the "9° Kleenaire" filter [R. 1379-1383]. He compared the operation of the Farr '479 filter with that of the "9° Kleenaire," frankly admitting the obvious similarities in their modes of operation [R. 1418-1423]. He pointed out that when both filters are clean, the air passes straight through both filters; as dust deposits on the screens the air goes down the open air passages of each until it finds clean screen and then goes on straight through each filter; in both there is a mixed flow of air, partly through the screens and partly down the passages; and in both the dust is deposited progressively deeper into the filter on the walls of the passages.

This mode of operation in both the Farr '479 filter and the "9° Kleenaire" filter is, we submit, exactly that specified by claims 4, 7 and 8 of the patent in suit, claim 4 describing such mode of operation as follows:

“. . . whereby the medium [air] may flow through the mesh of said [screen] members near the entrance of the panel when the filter is clean and partially through said passages and hence through the mesh of the members located progressively

towards the exit of the panel as the panel becomes loaded with [dust] particles.”

We, therefore, submit that the “9° Kleenaire” filter operated in substantially the same way as plaintiff’s filter covered by the Farr ’479 patent in suit, and that original Finding 4 [R. 59] and the new Finding 30 [R. 1179] are clearly erroneous.

**4. The Results Obtainable With the “9° Kleenaire” Were Adequate.**

The results obtainable with the “9° Kleenaire” were adequate and are fully comparable with those obtainable with the filter of the Farr ’479 patent in suit. Admittedly, the Kleenaire filter has somewhat lower average efficiency in removing dust and somewhat higher average pressure drop than the Farr filter, but the difference in results, we suggest, were merely differences in degree and not in kind.

Plaintiff’s expert Duncan made and tested a replica of a “9° Kleenaire” filter [R. 1379-1383], and his test results are shown in the graph Exhibit 54-B-2 [R. 1456]. This graph shows that for a dust load of 600 grams of dust the Kleenaire filter tested had an average dust removal efficiency of in excess of 70% and a pressure drop which started at 0.09” and rose to only 0.29”. Through the same range the Farr filter has an average dust removal efficiency of less than 75% and a pressure drop that started at 0.1” and rose to 0.13” [Ex. 13; R. 956-A]. Mr. Duncan made it clear that the Farr filter must be cleaned when the dust load rises to 500 or 600 grams of dust [R. 183-184], which may be considered as the normal operating life of such a filter before

cleaning is required. Within this range set by plaintiff's expert, the Kleenaire results are comparable with those of the Farr. Furthermore, the standards of the filter industry permit a pressure drop rise of up to 0.5" of water [R. 184-185, 339], and, obviously, the Kleenaire filter, which had a pressure drop rise to only 0.29" of water in such normal operating range, is well within the standards of the industry. There is absolutely no evidence in this case that the differences in efficiency or pressure drop between the Farr '479 filter and the Kleenaire filter, or, in fact, any other prior art filter, are in any way significant.

Mr. Duncan admitted that the "9° Kleenaire" replica tested by him had about the same operating characteristics and results as the prior art Air-Maze "Type B" filter [R. 1389-1390, 1393], and the uncontradicted evidence is that defendant Air-Maze has sold substantial quantities of such "Type B" filters in competition with the Farr filter [R. 333-334]. If such "Type B" filters are commercially saleable and acceptable, we suggest that the Kleenaire filter would likewise be acceptable with modern heating and ventilating equipment. The witness Meyer pointed out that while he had some difficulties in the early 1930's in keeping clean some of the Kleenaire filters that he used and sold, the reason for this was the inadequate propeller type fans they used with the filters at that early date and that with modern blower equipment the Kleenaire filters would be satisfactory [R. 1310-1311, 1314]. Mr. Meyer, at an early date, actually tested such Kleenaire filters with modern type blowers and found them satisfactory [R. 1323]. The witness Worth, the manufacturer of such Kleenaire filters, testified that he had no trouble with them [R. 1227].

The foregoing demonstrates the clear error in the District Court's Finding 26 [R. 1178] to the effect that the Kleenaire filters "had no utility." Such Kleenaire filters were extensively made, sold, and used, and some, at least, operated satisfactorily. By modern standards the Kleenaire filters would be adequate for ordinary heating and ventliating installations.

**5. The Farr '479 Patent in Suit Is Invalid in View of the Kleenaire Filters.**

As shown above, the Kleenaire filters embodied all of the elements of claims 4, 5, 7 and 8 of the Farr '479 patent in suit in the same combination, the elements operated in substantially the same way to produce comparable results. The mere fact that the Kleenaire filters may not have had as high an efficiency or as low a pressure drop as the Farr '479 filters does not rule them out as anticipations.

The law is clear that even an imperfect prior art device may invalidate a patent if the fact of prior use and sale is clearly established [it is admitted here] and if the prior art device embodied substantially the alleged invention covered by the patent in suit. *See: Brush v. Condit*, 132 U. S. 39, 10 S. Ct. 1, 33 L. Ed. 251 (1889); *H. Wenzel Tent & Duck Co. v. White Stag Mfg. Co.*, 199 F. 2d 740 (C. A. 9th, 1952).

It is, therefore, submitted that claims 4, 5, 7 and 8 of the Farr '479 patent in suit are clearly invalid because wholly anticipated by the Kleenaire filters.

**6. The Farr '479 Patent in Suit Is Invalid Because It Covers a Mere Substitution of Materials.**

In our Opening Brief of Appellants we pointed out (pp. 39-42) that the '479 patent in suit is invalid for lack of invention over the prior art Detroit Air Filter, as no invention was involved in merely substituting fly screen for cardboard in the Detroit Air Filter. Plaintiff's counsel conceded that if the Detroit Air Filter were made of wire screen instead of paper plaintiff would have no case here [R. 1134].

The prior art Kleenaire filters, made of fly screen and generally of the same construction as the filter covered by the Farr '479 patent in suit, plainly taught the use of such fly screen in such an air filter prior to the alleged invention of the patent in suit. In view of the prior Kleenaire filters, we reiterate that there was no invention involved in merely substituting such fly screen for the paper or cardboard in the Detroit Air Filter and that the patent in suit is clearly invalid as being no more than an obvious substitution of materials, under the authorities cited in our opening brief.

**7. The Farr '479 Patent in Suit Is Invalid Over the "45° Kleenaire" Filter.**

The District Court found [Finding 33, R. 1180] that defendants had not carried their burden of proof that the "45° Kleenaire," the filter media of which is shown in Exhibit CCC [R. 1458-1459], was ever actually made and sold. This, we submit, was clearly erroneous because the deposition testimony of the witnesses Worth and Flaig clearly establishes such fact [R. 1199, 1206-1211, 1232-1233, 1249-1250, 1270-1271].

However, regardless of whether Kleenaire filters with corrugations of  $45^\circ$  were ever actually sold, it is incontestable that such filters were *offered for sale* by the advertisements in Exhibit CCC [R. 1458-1459] and were illustrated in such printed publication in 1931 long prior to the alleged invention of the patent in suit, either of which facts may operate as anticipations to invalidate the Farr '479 patent in suit.

The particular pertinency of the " $45^\circ$  Kleenaire" filter is that its wire screen filter media with its corrugations set at a  $45^\circ$  angle and reversed in direction, is substantially *identical* with the alternative forms of the Farr filter shown in Figures 3 and 5 [R. 951] of the abandoned Farr patent application Serial No. 285,904 upon which the application for the Farr '479 patent in suit was based. Plaintiff's counsel in the District Court conceded that the '479 patent in suit discloses only one form of Farr's invention, the other forms being shown in the abandoned Farr application Serial No. 285,904 [R. 1165-1168]. As plainly stated by Farr in his abandoned application [R. 994], the form shown in Fig. 3 was his "preferred form of construction." If the Farr filter shown in Fig. 3 of the abandoned application was merely an alternative form of the invention to the form shown in the '479 patent in suit, which is conceded by plaintiff (typewritten transcript, p. 1164), we suggest that the " $45^\circ$  Kleenaire," which is substantially identical with such form shown in Fig. 3 of the abandoned application, is likewise an alternative to and equivalent to the filter of the '479 patent in suit. "Things which are equal to the same thing are equal to each other."

We, therefore, submit that the patentee Farr and plaintiff, by the admissions of its counsel, have established the substantial equivalency of the "45° Kleenaire" filter and the filter of the Farr '479 patent in suit and, we submit, the '479 patent in suit is, therefore, clearly invalid because anticipated by the Kleenaire filter.

8. **The Farr '479 Patent in Suit Is Invalid for Lack of Invention Because It Is Merely for an Assemblage of Old Elements Which Operate in Substantially the Same Way to Produce the Same Results as They Did in the Prior Art.**

This point was fully developed in our original Opening Brief of Appellant (pp. 27-38). There we pointed out that there was *no finding* by the District Court in this case that the old elements of the Farr '479 patent in suit "perform any additional or different function in the combination than they perform out of it," as required by the Supreme Court in *Great A. & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, at 172. Such rule was adopted and followed by this Court in *Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483, 100 U. S. P. Q. 289, at 291, stating:

"\* \* \* The Supreme Court further requires that in order for a combination patent to be upheld, there must be a specific finding that the old elements which made up this device perform an additional and different function in combination, than they perform out of it. No such finding was made in the case at bar \* \* \*."

This case has again been before the District Court, with the opportunity for it to make additional findings on this point, and yet the District Court has not done so.

We, therefore, respectfully reiterate that the judgment should be reversed upon the ground that the District Court has failed to make the findings of fact required by the Supreme Court and this Court to sustain the validity of the Farr '479 patent in suit which is otherwise for a mere assemblage of elements, all of which were old in the art.

#### IV.

#### Conclusion.

The alleged invention of the Farr '479 patent in suit was wholly forecast in the Kleenaire filters widely sold and offered for sale in the United States, and shown in printed publications, long prior to its earliest date of invention. Every element of claims 4, 5, 7 and 8 of the Farr '479 patent in suit was embodied in such Kleenaire filters, in which such elements operated in the same way to produce comparable results.

We submit that claims 4, 5, 7 and 8 of the Farr '479 patent in suit are, therefore, clearly invalid in law and that the judgment should be reversed.

Respectfully submitted,

HYDE, MEYER, BALDWIN & DORAN,

GEORGE S. BALDWIN,

HARRIS, KIECH, FOSTER & HARRIS,

FORD HARRIS, JR.,

DONALD C. RUSSELL,

*Attorneys for Appellants.*